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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,397

06/23/2006

Peter Richard Van Smirren

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT

PAPER NUMBER

3782

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,397	<b>Applicant(s)</b> VAN SMIRREN, PETER RICHARD	
	<b>Examiner</b> JUSTIN LARSON	<b>Art Unit</b> 3782	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1,3 and 5-23 is/are pending in the application.
- 5a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1,3,5-16 and 23 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/11 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5-11, 13-16, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuch (US 5,540,478 A).

Regarding claims 1, 3, 5-7, and 14-16, Schuch disclose a method of attaching a load carrier fixing member (11, to which a load carrier such as a roof rail can be attached, where no load carrier is actually being claimed) to a vehicle, the method comprising applying adhesive (14) to the vehicle roof (8, which is part of the "roof" structure), and attaching the fixing member (11) to the vehicle (Figure 3), wherein the fixing member includes an element (upwardly extending projection to which 33 is shown to be attached) on a top surface for attaching (capable of attaching, i.e. a load carrier

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could be attached instead of 33) a load carrier (such limitation being completely functional), the fixing member including a bottom surface with at least one undercut (see Figures where the adhesive is shown placed against an undercut/indented section of 11).

Regarding claims 8 and 9, a fixing member trim finisher (33) is removably attached to a non-adhered side of the fixing member (see Figure 3).

Regarding claims 10 and 11, the fixing member comprises at least one gap hider (33 or the part of 11 to the right of the adhesive, where this "portion" of the fixing member can be considered a gap hider to the extent that Figure 12 shows this portion covering a gap) that is positioned between the fixing member and the vehicle.

Regarding claim 13, the fixing member is secured in position using one or more locating members (one locating "member" being the portion of 11 that fits around the upward projection of 11 and the other locating "member" being the portion of 33 that rests against or extends over 17, where a "member" can be just about anything) which are shaped to hold the fixing member in place.

Regarding claim 23, a portion of the fixing member is adapted to be hooked under a part of the vehicle roof (see Figure 12).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuch in view of Beecher et al. (US 4,904,328 A).

Schuch discloses the method as claimed except for the step of cleaning the part (roof) of the vehicle to be worked on. Beecher, however, teaches that it was already known in the art to clean a bonding surface by sanding and/or wiping in order to increase the adhesive potential of the bond (see abstract and col. 1 lines 19-21). While Beecher focuses on FRP vehicle parts, one of ordinary skill in the art, after studying Beecher, through their own available knowledge and reasoning, would realize that such surface cleaning could be useful in just about any situation where bonding was needed, not limited to FRP parts. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to have cleaned the roof of Schuch before applying the adhesive, the motivation being to increase the adhesive potential in the manner taught by Beecher.

6. Claims 1, 3, 5-11, 13-16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cucheran (US 5,090,605 A) in view of Jacobsen et al. (US 4,792,180 A).

Regarding claims 1, 3, 5-7, and 14-16, Cucheran (Figure 3) discloses a method of attaching a load carrier (28) fixing member (40) to a vehicle, the method comprising attaching the fixing member (40) to the vehicle, wherein the fixing member includes an element (channel 56) on a top surface for attaching a load carrier (28). Cucheran fails to disclose the bottom surface (59) of the fixing member (40) including an undercut to which adhesive is applied. Cucheran discloses only that screws, rivets, or the like may

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be used to attach the fixing members to the vehicle (see col. 1 lines 61-64). Jacobsen, however, teaches that it was already known for a roof mounted vehicle accessory to include an undercut bottom surface so that adhesive can enter the undercut in order to allow a user to make the accessory flush with the roof (see col. 2 lines 57-63).

Especially considering that Cucheran is also concerned with the fixing member (40) being flush with the roof (see col. 2 lines 62-65, note that the pad 58 is not required by Cucheran, see "may include"), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have attached the fixing member of Cucheran to the vehicle roof using adhesives and to have provided an underside of the fixing member with an undercut, the motivation being to ensure a flush fit between the fixing member and the roof, as taught by Jacobsen.

Regarding claims 8 and 9, a fixing member trim finisher (60) is removably attached to a non-adhered side of the fixing member (see Figure 3).

Regarding claims 10 and 11, the fixing member comprises at least one gap hider (60) that is positioned between the fixing member and the vehicle.

Regarding claim 13, the fixing member is secured in position using one or more locating members (60) which are shaped to hold the fixing member in place (i.e. prevents side to side movement).

Regarding claim 23, a portion of the fixing member is adapted to be hooked under a part of the vehicle roof (the roof could be shaped so as to hook the structure of Cucheran's fixing member where the language "adapted to be hooked" imparts no

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specific structure, requiring only a capability of being hooked, where just about any structure is so capable).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cucheran in view of Jacobsen et al., further in view of Beecher et al. (US 4,904,328 A).

Modified Cucheran discloses the method as claimed except for the step of cleaning the part (roof) of the vehicle to be worked on. Beecher, however, teaches that it was already known in the art to clean a bonding surface by sanding and/or wiping in order to increase the adhesive potential of the bond (see abstract and col. 1 lines 19-21). While Beecher focuses on FRP vehicle parts, one of ordinary skill in the art, after studying Beecher, through their own available knowledge and reasoning, would realize that such surface cleaning could be useful in just about any situation where bonding was needed, not limited to FRP parts. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to have cleaned the roof of Cucheran before applying the adhesive, the motivation being to increase the adhesive potential in the manner taught by Beecher.

### ***Response to Arguments***

8. Applicant's arguments filed 7/18/11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN LARSON whose telephone number is (571)272-8649. The examiner can normally be reached on Monday-Friday, 9a-5p (EST). If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Larson/  
Primary Examiner, Art Unit 3782  
9/27/11